



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,135	10/20/2001	Bruce N. Ames	B00-001-2	7465

20350 7590 06/03/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

JONES, DWAYNE C

ART UNIT PAPER NUMBER

1614

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,135

Applicant(s)

AMES ET AL.

Examiner

Dwayne C. Jones

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25MAR2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-131 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/05</u> | 6) <input type="checkbox"/> Other: _____ |

428

DETAILED ACTION

Status of Claims

1. Claims 62-131 are pending.
2. Claims 62-131 are rejected.

Response to Arguments

3. Applicants' arguments filed on March 25, 2005 have been fully considered but they are not persuasive. The following arguments are present by applicants. First, applicants argue that one of skill in the art would not have been motivated from the teachings of Krishna et al. to evaluate other antioxidants or cytoprotective hydroxylamine compounds to protect cells from the deleterious effects due to oxidative damage. Second, applicants submit that because Krishna et al. studied the effect of ring size on secondary nitroxides, one having ordinary skill in the art would not have been motivated to utilize the teachings of Krishna et al. from secondary hydroxylaminyll compounds to the instantly claimed primary hydroxylaminyll compounds. Third, applicants allege that hindsight was used in the Office Action of record to reject the instantly claimed subject matter regarding primary hydroxylaminyll compounds over the teachings of Krishna et al. from secondary hydroxylaminyll compounds.
4. First, applicants argue that one of skill in the art would not have been motivated from the teachings of Krishna et al. to evaluate other antioxidants or cytoprotective hydroxylamine compounds to protect cells from the deleterious effects due to oxidative damage. However, one having ordinary skill in the art would have been motivated to

Art Unit: 1614

use primary N-hydroxylamines to offset the deleterious effects of reactive oxygen species to cells when the prior art specifically teaches that secondary N-hydroxylamines also perform this very same function. For this reason, the skilled artisan would expect that compounds with primary N-hydroxylamines would also reduce the effects of reactive oxygen species to cells because the only structural difference lies with the presence of absence of a hydrogen atom attached to the functional group of the N-hydroxylamine moiety.

5. Second, applicants submit that because Krishna et al. studied the effect of ring size on secondary nitroxides, one having ordinary skill in the art would not have been motivated to utilize the teachings of Krishna et al. from secondary hydroxylaminyl compounds to the instantly claimed primary hydroxylaminyl compounds. The major distinction between the instantly claimed subject matter and that of Krishna et al. lies with primary hydroxylaminyl compounds and secondary hydroxylaminyl compounds. The one having ordinary skill in the art would have been motivated to use primary N-hydroxylamines to offset the deleterious effects of reactive oxygen species to cells when the prior art specifically teaches that secondary N-hydroxylamines also perform this very same function. The skilled artisan would obviously expect that compounds with primary N-hydroxylamines would also reduce the effects of reactive oxygen species to cells because the only structural difference lies with the presence of absence of a hydrogen atom attached to the functional group of the N-hydroxylamine moiety. Moreover, the skilled artisan would even expect that the structurally-related compounds of primary N-hydroxylamines would react more readily than the secondary N-hydroxylamines due to

Art Unit: 1614

the absence of a secondary carbon-containing moiety, thus decreasing the steric hinderence of the secondary N-hydroxylamine. The amount and level of skill involved with substituting "bulky" groups, such as alkyl moieties for less "bulky" groups, such as a hydrogen atom, is well within the level of the skilled artisan. In fact, the replacement of an alkyl group for a hydrogen atom is expected and obvious, rather than as purported by applicants as unexpected and nonobvious because of the difference in steric hinderence between a primary N-hydroxylamine and a secondary N-hydroxylamine. Furthermore, one having ordinary skill in the art would have been motivated to use closely-related N-hydroxylamine-containing compounds and their derivatives, which clearly embraces primary N-hydroxyl amines due to the fact that the reaction between the unwanted reactive oxygen species, is with the N-hydroxylamine-containing moiety.

6. Third, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In particular, applicants allege that hindsight was used in the Office Action of record to reject the instantly claimed subject matter regarding primary hydroxylaminyl compounds over the teachings of Krishna et al. from secondary hydroxylaminyl compounds. One having ordinary skill in the art is provided with necessary and

Art Unit: 1614

required skill level and knowledge to differentiate, distinguish, and manipulate primary hydroxylaminy compounds and secondary hydroxylaminy compounds. Thus, the replacement of an alkyl group for a hydrogen atom is expected and obvious, rather than as purported by applicants as unexpected and nonobvious because of the difference in steric hinderence between a primary N-hydroxylamine and a secondary N-hydroxylamine. Clearly, it would have been obvious to the skilled artisan to utilize other hydroxylamine compounds and derivatives, which would obviously include primary hydroxylamine compounds and their derivatives, because the reaction between the oxidative damage lies between the reactive oxygen species and they hydroxylamine moiety.

Information Disclosure Statement

7. The information disclosure statement filed March 25, 2005, which was originally filed on December 3, 2003, have been reviewed and considered, see enclosed copy of PTO FORM 1449.

Claim Rejections - 35 USC § 112

8. The rejection of claims 117 and 120 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *reducing* neuronal cell death induced by beta amyloid peptide or amyloid beta peptide-induced locomotor impairment, does not reasonably provide enablement for being able to “*protect* against amyloid beta

Art Unit: 1614

peptide-induced neuronal cell death” or “*protect* against amyloid beta peptide-induced locomotor impairment” is withdrawn in response to the amendment of March 25, 2005.

9. The rejection of claims 66, 67, 69-91, 93, 94, 101-106, 113-115 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in response to the amendment of March 25, 2005

10. The rejection of claims 66, 69, 72, 75, 78, 81, 84, 87, 90, 93, 96, 99, 102, 105, 111, and 114 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in response to the amendment of March 25, 2005

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. The rejection of claims 62-131 under 35 U.S.C. 103(a) as being unpatentable over Krishna et al. is maintained and repeated for both the above-stated and reasons of record. Krishna et al. teach of the protective effects of inter alia hydroxylamines. Krishna et al. teach that cellular damage may result from the cytotoxicity of reactive oxygen species, (see column 1, page 3477). Krishna et al. also teach that the reactive oxygen species are byproducts of normal processes in aerobic environments, and when there are imbalances in these reactive oxygen species oxidative stress results to cells,

(see page 3477). Krishna et al. also disclose that hydroxylamines have been shown to protect mammalian cells exposed to reactive oxygen species, such as super oxide, hydrogen peroxide, organic hydroperoxides, and redox cycling and anticancer agents, (see column 2, page 3478). In addition, Krishna et al. teach of screening methods to test the effectiveness of hydroxylamines to provide protection to mammalian cells that are exposed to a reactive oxygen species, namely hydrogen peroxide. The results were performed with an in vitro assay, (see column 2, page 3478). In the assay model of this teaching the efficacy of the antioxidant, such as hydroxylamine, was evaluated by exposing the cells to a reactive oxygen species, namely hydrogen peroxide, and assessing the viability of the cells both in the absence and in the presence of a fixed concentration of the test compound, (see column 2, page 3480). The assessment would compare the amounts of the reactive oxygen species present, while the instant invention is comparing the amounts of the antioxidant of the hydroxylamine present after contact with the cells. There are many ways to measure the concentration of an assay, such as a decrease in the concentration of the unwanted species or compound, (as in Krishna et al.) or still by measuring the concentration of the antioxidant compound of the hydroxylamine (as is obviously claimed by applicant).

13. The instant claims differ only in screening methods for primary hydroxylamines whereas the prior art reference of Krishna et al. are directed to screening methods with the utilization of secondary amines. The skilled artisan would most certainly been motivated from the screening methods of Krishna et al. to employ other antioxidant or cytoprotective hydroxylamine compounds to protect cells from the deleterious effects

Art Unit: 1614

due to oxidative damage due to inter alia, reactive oxygen species. The generation of reactive oxygen species, as taught by Krishna et al., is evident in many various biochemical and aerobic environments. Accordingly, if a cellular event such as from a variety of scenarios, for instance ischemia or inflammation or cancer or cytokines or still other events, which can generate and cause oxidative damage to a cell, would be obviously protected with the presence of hydroxylamine compounds, as clearly taught by Krishna et al. Clearly, it would have been obvious to the skilled artisan to utilize other hydroxylamine compounds and derivatives, which would obviously include primary hydroxylamine compounds and their derivatives, because the reaction between the oxidative damage lies between the reactive oxygen species and they hydroxylamine moiety. The skilled artisan would additionally be motivated to use primary hydroxylamine compounds and their derivatives especially since the hydroxylamine moiety of a primary hydroxyl amine is less sterically hindered than a primary hydroxylamine compound.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1614

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, and Fridays from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, may be reached at (571) 272-0951. The official fax No. for correspondence is (571)-273-8300.

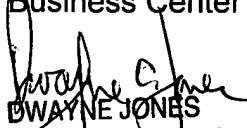
Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see <http://pair-direct.uspto.gov>. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR

Art Unit: 1614

only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 1-866-217-9197 (toll free).


DWAYNE JONES
PRIMARY EXAMINER

Tech. Ctr. 1614

June 1, 2005